

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the above amendment and the following remarks, which place the application into condition for allowance.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-21 are pending in this application. Claims 20 and 21 have been previously withdrawn. Claims 1-19 are rejected in the Office Action mailed September 1, 2006. By this Amendment, claim 22 is added, drawn to subject matter disclosed in the Specification, for example, on page 7, lines 4-6. It is believed that no new subject matter has been added as a result of the amendments to the claims.

In response to the Examiner's assertion that the Information Disclosure Statement filed on March 22, 2004 fails to comply with 37 C.F.R. § 1.98(b)(1), submitted herewith is a corrected PTO Form 1449 for the IDS filed March 22, 2004. Accordingly, Applicant's attorneys respectfully request consideration of the information referred to therein.

II. REJECTION OF THE CLAIMS UNDER 35 U.S.C. § 112

On page 2 of the Office Action, claim 9 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner objects to the term "polyester felt." Citing two references (Smith, *Textiles in Perspective*, page 254, 255, and 418; Collier, *Understanding Textiles*, pages 358 and 359), the Examiner asserts that "felt" can only be

made from wool, thereby making “polyester felt” unclear. This rejection is traversed for at least the following reasons.

The Smith reference, on page 254, notes that although felt was originally made from wool, in the felting process wool is “sometimes mixed with other fibers.” In a dictionary-like appendix to the same reference, on page 418, Smith defines felt as “[a] nonwoven fabric in which fibers are firmly entangled. True felts are made of wool, hair, or fur fibers. *Felts made from other fibers* often have a bonding agent.” (Emphasis added). The broad recitation of “other fibers” does not limit the selection to natural fibers. Therefore, Applicant’s attorneys respectfully submit that Smith teaches the use of synthetic fibers, a class of which includes polyester, in felts.

The Collier reference on page 358 also indicates that traditional felts were made of wool, stating, “To understand the process by which felt is formed, it is necessary to review the structure of the wool fiber from which it is made.”. Additionally, Collier teaches the combination of wool with other fibers to reduce the cost of the material. Collier on page 359, specifically refers to the use of thermoplastic fibers in nonwoven fabrics and felts, stating, “Techniques by which fabrics are made directly from fibers [] have been used for centuries in the production of felt []. With the development of manufactured fibers, and, in particular, the synthesis of *thermoplastic fibers*, technologies have evolved that have made possible the large-scale production of nonwoven fabrics.” (Emphasis added). Applicant’s attorneys respectfully submit that this teaching of thermoplastic fibers includes the subset of polyester fibers.

In light of the two references cited by the Examiner, Applicant’s attorneys respectfully submit that the term “polyester felt” is not unclear, and includes a felt with some content of

polyester. Accordingly, Applicant's attorneys respectfully request that the § 112 rejection of claim 9 be withdrawn.

III. THE NONSTATUTORY OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTIONS AND THE REJECTIONS UNDER 35 U.S.C. § 102(b) AND 35 U.S.C. § 103(a)

In the Office Action, claims 1-4 and 10 are rejected on the grounds of nonstatutory, obviousness-type double patenting as allegedly being unpatentable over claim 5 of U.S. Patent No. 5,955,017 to Foffano, et al. ("Foffano"), which shares a common inventor with the instant invention. In the Office Action, the Examiner asserts that although the claims are not identical, they are not patentably distinct from each other. Applicant's attorneys respectfully disagree. In addition, claims 1, 2, 5 and 10 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Foffano. Further, claims 3 and 4 are rejected under § 102(b) as allegedly being anticipated by Foffano as evidenced by Smith .

Additionally, claim 6 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Foffano as applied to claim 1, and further in view of U.S. Patent No. 4,187,623 to Sassler ("Sassler"); claims 7 and 9 are rejected under § 103(a) as allegedly being unpatentable over Foffano as applied to claim 1, and further in view of German Patent No. DE 19512499C1 to Huebner et al. ("Huebner"); claim 8 is rejected under § 103(a) as allegedly being unpatentable over Foffano as applied to claim 1, and further in view of U.S. Patent No. 5,343,638 to Legassie et al. ("Legassie"); claims 11 and 12 are rejected under § 103(a) as allegedly being unpatentable over Foffano as applied to claim 1, and further in view of U.S. Patent No. 4,793,882 to Brehmer et al. ("Brehmer"); claims 11, 13-15 and 17 are rejected under

§ 103(a) as allegedly being unpatentable over Foffano as applied to claim 1 in view of U.S. Patent No. 4,428,130 to Perotto ("Perotto '130"); and claims 11, 16 and 19 are rejected under § 103(a) as allegedly being unpatentable over Foffano in view of U.S. Patent No. 5,050,319 to Perotto ("Perotto '319"). The rejections are traversed for at least the following reasons.

As recited in claim 1 of the instant application, the instant invention is directed to a method of manufacturing a part of a sports boot in composite material from flat elements such that a first flexible material and a second flexible material are configured to form the external and internal faces, respectively, of a boot part with a polymerized foamable binding material binding the two faces.

As presently understood by Applicant's attorneys, Foffano, the primary reference, relates to a method for producing soles for shoes, which initially includes the production, by molding, of a sole that has a perimetric ridge that protrudes downwards. The sole is then placed on to a plunger of a mold that has a head which is shaped complementarily to the lower surface of the sole and with respect to the ridge. The plunger is configured to include a recess for containing the ridge and a gap for the intended flow of a second material to be injected. The process is followed by trimming of the flash.

Foffano and the instant invention differ significantly. Firstly, although Foffano is related to a method for manufacturing a part of a shoe, it does not teach or disclose the use of a composite material or flat elements. Further, it does not teach the steps of preparing a first blank in a first flexible material intended to form the external face of the boot part, and a second blank in a second flexible material intended to form the internal face of the boot part. It also does not disclose placing the first and second blanks on the impression of a first half of a mold with the first blank against the impression, and closing the mold by using its second half. Additionally,

Foffano does not teach the step of injection molding a foamable binding material between the first blank and the second blank to give the resulting boot part its final three-dimensional shape. Though claim 5 of Foffano claims a step of arranging an upper in a mold and connecting the sole with an upper, it does not, however, disclose the above mentioned steps involved in the process. The Examiner compares the injection molding of Foffano to the composite material of the instant invention, whereas the composite herein is a sandwich formed by the first and second flexible materials and the foamable binding material.

Secondly, molding a resting surface of a sole from rubber as disclosed in Foffano is not comparable to the first blank of the instant invention. Additionally, the upper in Foffano is also not comparable to the second blank of the instant invention. The relied upon portions of Foffano disclose the formation of the sole of a shoe comprising a perimetric ridge and do not teach or disclose the details of the formation of the upper, as recited in instant claim 1. Instead, Foffano discloses the bonding of an upper to a sole, where the upper already has a three-dimensional shape. The bonding in Foffano does not change the shape of the two surfaces being bonded. As previously discussed, this is not the case with the instant invention which produces a final three-dimensional boot part from two flexible blanks.

Additionally, Applicant's attorneys have amended the application to include claim 22 which is directed to the boot part immediately released from the mold following polymerization of the injected material. The boot part thus obtained is in its final three-dimensional shape. Support for this claim may be found, for example, in the specification of the instant application on page 7, lines 4-6. Again, this is different than Foffano which teaches the combination of two three-dimensional components, a sole and an upper, by injection molding a collar and a shell to attach the two. Neither the sole nor the upper changes shape in the process.

Sassler, Huebner, Legassie, Brehmer, Perotto '130 and Perotto '319, either alone or in combination, fail to correct the deficiencies of Foffano.

For at least the foregoing reasons, Applicant's attorneys respectfully submit that independent claim 1 patentably distinguishes over the relied portions of Foffano, Sassler, Huebner, Legassie, Brehmer, Perotto '130 and Perotto '319, and is therefore allowable. Further, claims 2-19 and 22 that depend from claim 1 are allowable therewith.

Statements appearing above with respect to the disclosures in the cited references represent the present opinions of the Applicant's undersigned attorney and, in the event that the Examiner disagrees with any such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective reference providing the basis for a contrary view.

CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are patentable over the prior art, and an early and favorable consideration thereof is solicited.

Please charge any fees incurred by reason of this response and not paid herewith to Deposit Account No. 50-0320.

Respectfully submitted,
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